



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,975	11/13/2001	Shunji Imai	43890-552	6015

7590 08/01/2005

MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
----------	--------------

1746

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/986,975	Applicant(s) IMAI ET AL.	
	Examiner Joseph L. Perrin, Ph.D.	Art Unit 1746	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 5-10 and 19-22.
Claim(s) withdrawn from consideration: 11-18 and 23-36.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Joseph L. Perrin, Ph.D.
Primary Examiner
Art Unit: 1746

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive.

Applicant argues that WULF does not disclose the "speed reducer" as recited in claim 1. Applicant appears to rely on the "speed reducer" as a point of novelty over the prior art. However, the Examiner disagrees that the broad term "speed reducer" reads over the prior art of record. It is noted that the language "speed reducer" is very broad and reads on any structure capable of performing such function. Clearly, WULF discloses a rotary drive system commensurate with applicant's disclosed rotary drive system. Clearly, one of ordinary skill in the art would have the knowledge to understand that the WULF drive system inherently must include means for reducing speed in order to provide the decreasing of speed to the rotary drive system. In WULF, the motor affects blade speed same as applicant's invention. However, it is abundantly clear that between the motor and blade there are various structural components which assist in reducing the speed of the blade including structural components which rely on frictional forces to reduce speed of a rotary blade, also including applicant's invention. Otherwise, the blade would be a free spinning blade. Applicant further describes structural equivalents of a "speed reducer" (on page 32, lines 2-4 of the original disclosure) to include gear systems and pulley systems. It is further noted that the intended use of reducing speed is afforded little patentable weight. In apparatus claims, it is well established that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Applicant's argument that "the use of a speed reducer would not be desired because of the blender's need to increase blade speed relative to motor speed" is not persuasive because, as previously indicated, the rotary drive system of WULF not only "increases" blade speed but also "decreases" blade speed.

With respect to claim 2, applicant's incorporation of the "speed reducer" limitation from dependent claim 4 does not overcome the original rejection of both claims 2 and 4 for at least reasons of record and reasons indicated above.

Accordingly, since WULF discloses a rotary drive apparatus as well as frictional components fully capable of reducing speed between a motor and blade, recitation of WULF reads on applicant's claimed invention.

With respect to MISENHIMER, applicant argues that the "gear means" of MISENHIMER does not function as a "speed reducer" as claimed by applicant and further relying on the intended use of the claimed structure. As clearly indicated above, such gear means are disclosed by applicant as structural equivalents. Moreover, the position is taken that the gear means of MISENHIMER, which translates power from a motor to a blade, is fully capable of functioning in the same manner as described above in WULF. The mere frictional forces of the gear means which reduce the speed of the blade upon reduction in motor power reads on the structural limitation of a "speed reducer" in the claimed apparatus. Again, in the absence of such function the blade of MISENHIMER would be a free spinning blade. Furthermore, applicant's argument that MISENHIMER "is not necessarily designed to reduce speed" is not persuasive. The structural limitations of MISENHIMER fully anticipate those of applicant and the structural limitations are fully capable of performing applicant's intended use of reducing speed. That is, there is no STRUCTURAL difference with respect to applicant's broad terminology of a "speed reducer". As previously indicated, a recitation of the intended use of the claimed invention must result in a STRUCTURAL difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (emphasis added). Accordingly, recitation of MISENHIMER reads on applicant's claimed invention.

Regarding the claims rejection under 35 USC §103, applicant's arguments are substantially cumulative to the previous response and still not persuasive for reasons of record.